

REMARKS

This Amendment is submitted in reply to the final Office Action mailed on January 8, 2009. A Petition for a one month extension of time is submitted herewith this Amendment. The Commissioner is hereby authorized to charge \$130.00 for the Petition for a one month extension of time and any additional fees that may be required or credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 0112701-00486 on the account statement.

Claims 1, 3-12 and 14-17 are pending in the application. Claims 2 and 13 were previously cancelled without prejudice or disclaimer. In the Office Action, Claims 1, 3-12 and 14-17 are rejected under 35 U.S.C. §112, first paragraph. Claims 1, 3-12 and 14-17 are rejected under 35 U.S.C. §112, second paragraph. Claims 1, 5, 8, 10 and 11 are rejected under 35 U.S.C. §102(b). Claims 1, 3-12 and 14-17 are rejected under 35 U.S.C. §103(a). In response, Applicants have amended Claims 1 and 12. The amendments do not add new matter and are supported in the specification at page 2, lines 5-13; page 4, lines 12-26; Examples 1-2. In view of the amendments and for at least the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 1, 3-12 and 14-17 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Patent Office asserts that, "as claimed, the storage of product at room temperature has not been disclosed. Further, foam stability for 2 hours is not the same as product stability for at least one month, as instantly claimed. Furthermore, it is not clear as to what is included in the term 'room temperature stable' as recited in the rejected claims." The Patent Office also asserts that "[t]here is not recitation of 'room temperature microbial stable for at least one month' in the original disclosure." See, Office Action, page 2, lines 26-31. With respect to Claims 1 and 12, the Patent Office also asserts that "[t]he recitation of 'the milk product is room temperature microbial stable for at least one month and does not need to be cooled to provide the foamed composition,' also raises the issue of new matter as the microbial stability for one month has not been recited in the original disclosure." See, Office Action, page 3, lines 4-12. With respect to Claim 1, the Patent Office asserts that "[t]he recitation of 'the milk product for providing a room temperature both by shaking and with a foaming device,' also raises the issues of enablement as the limitation of

shaking and using a foaming device together as claimed has not been recited in the original disclosure.” See, Office Action, page 3, lines 13-20.

In response, Applicants have amended independent Claims 1 and 12 to recite, in part, milk products and methods for making same, respectively, for providing at room temperature, either by shaking or with a foaming device, a foamed composition for beverages, the milk product is room temperature ~~microbial~~-stable for at least one month and ~~does-is not need to be~~ cooled below room temperature to provide the foamed composition. The amendments do not add new matter and are supported in the specification at, for example, page 2, lines 5-13; page 4, lines 12-26; Examples 1-2.

With respect to the phrase “microbial stable,” Applicants note that the word “microbial” has now been deleted from Claims 1 and 12. Accordingly the rejections of the present claims under 35 U.S.C. §112, first paragraph (*i.e.*, enablement, written description and new matter) with respect to the word “microbial,” are now rendered moot.

Further, the Patent Office admits that the phrase “room temperature stable” is enabled by the present specification. See, Office action dated June 25, 2007, lines 17-21. Applicants also respectfully submit that the skilled artisan would immediately appreciate what is meant by the phrase “room temperature stable,” as required, in part, by the present claims. For example, in the Office Action, the rejection of Claims 1, 3-12 and 14-17 under 35 U.S.C. § 112, second paragraph, as being indefinite for the recitation of “the milk product is room temperature stable for at least one month and does not need to be cooled to provide the foamed composition,” was withdrawn based on applicant’s amendment reciting “microbial stable.” See, Office Action, page 4, lines 7-11. However, Applicants respectfully submit that, even upon deletion of the word “microbial,” the rejection under 35 U.S.C. § 112, second paragraph is still inapplicable to the present claims. For example, any person having ordinary skill in the art of food packaging or food sterilization would immediately appreciate that the phrase “room temperature stable” means that the food product is capable of being stored at ambient (*i.e.*, room temperature) for a designated amount of time without experiencing bacterial growth or rapid deterioration of the integrity of the product such as, for example, changes in texture, consistency, flavor, or ability to resist microbiological attack. Indeed, “room temperature stability” is typical synonymous with phrases such as “shelf stability” or “shelf-lives” of products and is one of the most basic concepts

involved with food packaging. Accordingly, Applicants respectfully submit that the skilled artisan would immediately appreciate what is meant by the phrase “room temperature stable.”

With respect to the Patent Office’s rejection of the phrase “room temperature microbial stable for at least one month,” Applicants respectfully submit that the phrase is fully supported in the specification and was disclosed in a way to enable one of ordinary skill in the art at the time of the invention to make or use the product with the recited characteristics. For example, in Example 2, the specification specifically states that “[t]he product obtained, shaken vigorously by hand, foams very well without being previously chilled. Poured on hot coffee into a cup, the product forms a thick foam layer of about 1 cm in height, which remains stable for at least 10 minutes. Part of the product disperses into the coffee, whitening it as would do any coffee creamer, without showing any flocculation. On storage, the product remains stable for months without any visible sign of physical instability. It is possible with the product of the invention to reach an overrun of about 300% (reached by using whipping tools) and the foam obtained remained stable for more than 2 hours at room temperature.” See, specification, page 4, lines 11-31 (emphasis added). Thus, it is clear that after being shaken or whipped to produce a foam, the foam is stable for more than 2 hours at room temperature. However, prior to whipping and during storage, the product (pre-foamed) remains stable for months without degradation. Accordingly, although the words “stable for at least one month” are not contained in the specification *verbatim*, Applicants respectfully submit that the skilled artisan would immediately appreciate that the product during storage is stable for at least one month since the specification describes stability for months. Moreover, Applicants also note that *verbatim* recitation of claim elements is not required for purposes of 35 U.S.C. §112.

Regarding the Patent Office’s rejection of Claim 1 under 35 U.S.C. §112, first paragraph for the recitation of “both by shaking and with a foaming device,” Applicants note that Claim 1 has been amended to recite, in part, a milk product for providing at room temperature, either by shaking or with a foaming device. Accordingly, Applicants respectfully submit that this rejection is now rendered moot.

In the Office Action, Claims 1, 5, 8, 10 and 11 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No.

4,012,533 to Jonas (“Jonas”). Applicants respectfully submit that *Jonas* is deficient with respect to the present claims.

Currently amended independent Claim 1 recites, in part, milk products that are room temperature stable for at least one month and are not cooled below room temperature to provide the foamed composition. The amendment does not add new matter. The amendment is supported in the specification at, for example, page 4, lines 12-26. Although the phrase “not cooled below room temperature” is not explicitly recited in the specification, Applicants respectfully submit that the skilled artisan would immediately appreciate that when the specification recites that “[t]he milk product does not require cooling prior to foaming,” it is clear that the product is not cooled below room temperature. For example, a person of ordinary skill in the art of foaming dairy beverages will appreciate that such products typically require cooling below room temperature, or even freezing, to maintain the product’s stability and resistance to microbiological attack upon storage of the product. Further, the references in the specification that discuss changing the temperature of the products are typically when the products are “UHT treated, cooled, homogenized again, cooled, and stored.” See, for example, Examples 1-2. Since the temperature of the product is increased dramatically during UHT treatment, the temperature of the product must then be brought down to ambient temperature to be packaged and then stored. Moreover, room temperature is specifically recited several times in the specification. See, for example, page 2, lines 11-12. Accordingly, when read in view of the specification and the general knowledge of the art of food sterilization and food packaging, the skilled artisan would immediately appreciate that the product of the present claims is merely cooled to room temperature during cooling.

Thus, the presently claimed milk products and methods of producing same relate to milk products that may be foamed by simple hand shaking independently of the way the product is produced. The milk products also do not require cooling below room temperature prior to foaming. The product remains room temperature stable for a long time (*i.e.*, at least one month). See, specification, page 2, lines 5-13; page 4, Example 2. In contrast, Applicants respectfully submit that *Jonas* fails to disclose each and every element of the present claims.

Jonas fails to disclose or suggest milk products that are room temperature stable and are not cooled below room temperature to provide the foamed composition as required, in part, by

independent Claim 1. Instead, *Jonas* specifically requires chilling of its products to form foam compositions. More particularly, the examples in *Jonas* teach whipping in a continuous ice cream freezer at 46-50°F, whipping in an M-10 Creamery Package continuous freezer at 47-48°F and whipping in a bowl jacketed with slush ice or ice water slurry to maintain a whip temperature of 40°F. See, *Jonas*, col. 10, lines 24-30; col. 11, lines 47-51; col. 12, lines 50-55, and col. 14, lines 46-68. Not only does the composition in *Jonas* require cooling prior to whipping, it also requires freezing after the whipping step to maintain stability. See, *Jonas*, col. 10, lines 35-37 and 56-58; col. 11, lines 54-56; col. 12, lines 63-68, and col. 14, lines 67-68. Therefore, rather than the room temperature preparation of the present claims, *Jonas* teaches a consistent cold process to form its composition.

The Patent Office maintains that *Jonas* teaches that it is essential that whipping be carried out above the freezing temperature of the mixture (col. 8, lines 15-25) and that combining fat and protein as an emulsion at 60°F can serve as feed for whipping (col. 9, lines 50-55). See, Office Action, page 8, lines 9-18. Applicants submit, however, that these excerpts still do not overcome the deficiencies of *Jonas* since the present claims require a room temperature product that is foamed without cooling below room temperature. Even if *Jonas* teaches whipping the product above freezing temperatures or combining fat and protein emulsions at 60°F, as the Patent Office asserts, this still does not teach or suggest a room temperature product formed without cooling below room temperature. As discussed above, *Jonas* specifically teaches that the product may be fed at 63-64°F into a freezer where the product is whipped, but outputs a whipped product at 46-50°F, which is clearly below room temperature. See, *Jonas*, col. 10, lines 24-30, col. 11, lines 47-51; col. 12, lines 28-30, and column 15, lines 52-62. Therefore, *Jonas* teaches a product that needs to be cooled below room temperature to provide a foamed composition.

The Patent Office also asserts that “cooling is a relative term designating lowering of temperature and since the applicant has not specified the initial temperature or whipping temperature of the milk product of the invention, the cooling requirement as recited is relative.” The Patent Office also asserts that the recitation “does not need to be cooled” is not a positive recitation that the product is not cooled prior to providing the foamed composition. See, Office Action, page 2, line 20-page 3, line 1. In response, Applicants note that independent Claims 1 and 12 have been amended to recite, in part, that the milk products are not cooled below room

temperature to provide the foamed composition. Further, as is discussed above, although the phrase “not cooled below room temperature” is not explicitly recited in the specification, Applicants respectfully submit that the skilled artisan would immediately appreciate that when the specification recites that “[t]he milk product does not require cooling prior to foaming,” it is clear that the product is not cooled below room temperature. For example, a person of ordinary skill in the art of foaming dairy beverages will appreciate that such products typically require cooling below room temperature, or even freezing, to maintain the product’s stability and resistance to microbiological attack upon storage of the product. Further, the references in the specification that discuss changing the temperature of the products are typically when the products are “UHT treated, cooled, homogenized again, cooled, and stored.” See, for example, Examples 1-2. Since the temperature of the product is increased dramatically during UHT treatment, the temperature of the product must then be brought down to ambient temperature to be packaged and then stored. Moreover, room temperature is specifically recited several times in the specification. See, for example, page 2, lines 11-12. Accordingly, when read in view of the specification and the general knowledge of the art of food sterilization and food packaging, the skilled artisan would immediately appreciate that the product of the present claims is merely cooled to room temperature during cooling.

Moreover, anticipation is a factual determination that “requires the presence in a single prior art disclosure of each and every element of a claimed invention.” *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747 (Fed. Cir. 1987) (emphasis added). Federal Circuit decisions have repeatedly emphasized the notion that anticipation cannot be found where less than all elements of a claimed invention are set forth in a reference. See, e.g., *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1370 (Fed. Cir. 2002). As such, a reference must clearly disclose each and every limitation of the claimed invention before anticipation may be found. Because *Jonas* fails to disclose each and every element of the present claims, *Jonas* fails to anticipate the present claims.

Accordingly, Applicants respectfully request that the anticipation rejections of Claims 1, 5, 8, 10 and 11 under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) be reconsidered and withdrawn.

In the Office Action, Claims 3-4 and 6-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jonas* in view of U.S. Patent No. 6,033,711 to Gonsalves, et al. ("*Gonsalves*"). Applicants respectfully submit that the patentability of Claim 1, as established above, renders moot the obviousness rejection of dependent Claims 3-4 and 6-7. Moreover, the Patent Office relies on *Gonsalves* to recite elements solely claimed in the dependent claims.

In the Office Action, Claims 9, 12 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jonas* in view of *Gonsalves*, further in view of U.S. Patent No. 5,759,609 to Lynch ("*Lynch*"). Applicants submit that the patentability of Claim 1, as established above, renders moot the obviousness rejection of Claim 9. Regarding independent Claim 12, Applicants respectfully submit that the cited references, taken alone or in combination, fail to disclose each and every element of the present claims.

For example, as states above with respect to Claim 1, *Jonas* fails to disclose or suggest a milk product that is room temperature stable and is not cooled below room temperature to provide the foamed composition as is also recited, in part, by Claim 12. *Gonsalves* and *Lynch* fail to remedy this deficiency. Instead, *Gonsalves* is entirely directed to a fat-free/low-fat frozen whipped topping, preferably a non-dairy, frozen whipped topping which can be freeze-thawed stable and which can retain a stable foam structure and texture for around 3 weeks during storage. See, *Gonsalves*, col. 1, lines 10-15. *Gonsalves* teaches essentially a *non-dairy* food product, which teaches away from the present claims, which are directed to a milk product. Moreover, there is no teaching or guidance in *Gonsalves* regarding a method of forming a milk product that provides a foamed composition for beverages, in accordance with Claim 12.

Lynch is entirely directed to a low-fat whipped topping. More specifically, *Lynch* is directed to a dairy-free non-fat whipped topping food product that can be stored frozen in an unwhipped state for an indefinite period of time, thawed and whipped into a whipped dessert, which explicitly teaches away from Claim 12. See, *Lynch*, col. 2, lines 8-10. Moreover, *Lynch* fails to disclose or suggest a method of forming a milk product for providing at room temperature a foamed composition for beverages as required, in part, by Claim 12.

In the Office Action, Claims 15-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Jonas* in view of *Gonsalves*, further in view of the combination of *Lynch* and U.S. Patent No. 3,230,091 to Thompson ("*Thompson*"). Applicants submit that the patentability

of Claims 1 and 12, as established above, renders moot the obviousness rejection of Claim 16, which is dependent from Claim 12, and Claims 15 and 17, which are dependent from Claim 1. Moreover, the Patent Office relies on the cited references to recite elements of the dependent claims.

In the Office Action, Claim 1, 3-8, 10-11, 15 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,519,440 to Staackmann (“*Staackmann*”) in view of *Gonsalves*. Applicants respectfully submit, however, that the skilled artisan would have no reason to combine the cited references because the references teach away from each other and are directed toward products having completely different objectives.

For example, *Staackman* is entirely directed to providing a dairy product having storage stability and resistance to microbiological attack at room temperature. See, *Staackman*, col. 1, lines 49-68. In contrast, and as discussed above, *Gonsalves* is directed to a fat-free/low-fat frozen whipped topping, preferably a non-dairy, frozen whipped topping which can be freeze-thawed stable and which can retain a stable foam structure and texture for around 3 weeks during storage. See, *Gonsalves*, col. 1, lines 10-15. *Gonsalves* teaches essentially a non-dairy food product, which not only teaches away from *Staackmann*, but also teaches away from the present claims, which are directed to a milk product. *Gonsalves* further teaches a frozen whipped topping, which also teaches away from *Staackmann*, as well as the present claims.

As such, the products and methods of the cited references explicitly teach away from the combination with each other and are directed toward products having completely unrelated objectives. Accordingly, the skilled artisan would have no reason to combine the cited references to arrive at the present claims. Indeed, it would be a stretch for the skilled artisan, aimed at providing a dairy product having storage stability and resistance to microbiological attack at room temperature as in *Staackmann*, to arrive at such a result by reviewing *Gonsalves*, which is aimed solely at providing a non-dairy and frozen whipped topping. Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there exists no reason for the skilled artisan to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Applicants respectfully submit that what the Patent Office has done here is to apply hindsight reasoning by attempting to selectively piece together teachings of each of the

references in an attempt to recreate what the claimed invention discloses. Applicants also submit that if it were proper for the Patent Office to combine any references to arrive at the present claims simply because each reference suggests an element of the present claims, then every invention would effectively be rendered obvious. Instead, the skilled artisan must have a reason to combine the cited references to arrive at the present claims. Applicants respectfully submit that such a reason is not present in the instant case.

Moreover, in response to the Patent Office's assertion that Applicants have addressed the references individually and not as a combination of references, see, Office Action, page 9, lines 11-15, Applicants respectfully submit that, to the extent that the references are discussed individually, it is not to address the rejections as anticipation rejections, but rather to point out the deficiencies of the cited references. In this case, the cited references also fail to disclose each and every element of the present claims.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claim 1, 3-12 and 14-17 be reconsidered and the rejections be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same. In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

~~K&L GATES LLP~~

BY

Robert M. Barrett
Reg. No. 30,142
Customer No. 29157
Phone No. 312-807-4204

Dated: April 21, 2009